REMARKS

Applicant deeply appreciates the indication that prior rejections under 35 U.S.C. § 103 are overcome. A three-month extension of time fee is included. Deposit Account 20-0823 may be charged a fee of $555 (fee code 2253) for the extension fee. Included herewith is a Request for Continued Examination ("RCE"). Deposit Account 20-0823 may be charged a fee of $405 (fee code 2801) for the request for continued examination. In addition, in the event that any additional fees are necessary, such fees are hereby authorized to be charged to our Deposit Account 20-0823.

Rejection under 35 U.S.C. § 112, First Paragraph – Written Description:

Claims 23, 25-31, 35, 37-39, 41-44 and 52-59 were rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement. Applicant has attached the Declarations under 37 C.F.R. §1.132 of Mark Yoder (see Appendix 1) and Michael Phillips (see Appendix 2), who are two renown experts in the field of electronic speech recognition. Both individuals clearly indicate that the term "adaptive speech recognition system" is well known in the art for a specific type of commercially available machine that digitizes an analog voice signal and analyzes the digital voice signal using a processor to identify the speaker. Both Mark Yoder and Michael Phillips believe that anyone skilled in the art of deploying an "adaptive speaker identity verification system" would clearly understand this standard industry terminology and would not have to have any additional details regarding the computing platform such as the processors, memory, and machine-readable media. Both individuals have reviewed

Claims 23, 25-31, 35, 37-39, 41-44 and 52-59 and U.S. Patent Application No. 09/886,824 and believe that the Claimed Invention could be readily made by such a person skilled in the art using a common adaptive speaker identity verification system since it is a relatively simple and straightforward process that does not require any undue experimentation. Both individuals believe that the term "adaptive speaker identity verification system" would be well understood and the specification of a particular hardware configuration is not necessary and the Invention is not dependent upon a particular hardware or operating system configuration as it can be implemented on the "machine" (computing platform/operating system configuration) on which the adaptive speaker identity verification system runs.

To support his conclusion, both Mark Yoder and Michael Phillips have provided literature from seven different companies manufacturing adaptive speaker identity verification systems. All of these systems could be easily adapted, without any undue experimentation, to perform the Applicant's Invention, as recited in Claims 23, 25-31, 35, 37-39, 41-44 and 52-59. Therefore, the mere reference to an "adaptive speaker identity verification system" is more than sufficient according to these experts to provide an adequate written description of the Invention, as claimed. It is also important to note that the description of the hardware in most of these systems is sparse and in some cases, like IBM® (Exhibit B of Declarations), Nuance Communications, Inc. (Exhibit C of Declarations), PerSay Ltd. (Exhibit F of Declarations), and SpeechWorks International, Inc. (Exhibit G of Declarations), it is virtually nonexistent. This proves that the "adaptive speaker identity verification system" is a standard, commercially

available product, where a description of the hardware is not necessary to put a person skilled in the art in complete possession of the Applicant's Invention, as claimed.

The inquiry into whether the description requirement is met must be determined on a case-by-case basis and is a question of fact. *In re Wertheim*, 541 F.2d 257, 262, 191 U.S.P.Q. 90, 96 (C.C.P.A. 1976). A description as filed is presumed to be adequate; unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 U.S.P.Q. 367, 370 (C.C.P.A. 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. In this case, the absence of a description of hardware used in the invention is only reasonable if the hardware was not a common and commercially available product. It is the opinion of voice recognition experts Mark Yoder and Michael Phillips that the Invention described in U.S. Patent Application No. 09/886,824 can easily be adapted to any commercially available "adaptive speaker identity verification system."

The Manual for Patent Examining Procedure ("M.P.E.P.") §2163.07(a) is very clear on this point, in that by: "...disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, **even though it says nothing explicit concerning it.** The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter." (emphasis added). *In re Reynolds*, 443 F.2d 384, 170 U.S.P.Q. 94 (C.C.P.A. 1971); *In re Smythe*, 480 F. 2d 1376, 178 U.S.P.Q. 279 (C.C.P.A. 1973). Therefore, any commercially available "adaptive speaker identity verification

system" can operate to perform the invention, as claimed, so that there is no need to go into any specific description of hardware in order meet the written description requirement under 35 U.S.C. §112, first paragraph. It is respectfully believed that the Declarations of Mark Yoder and Michael Phillips provide the extrinsic evidence needed to establish inherency. "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999).

Therefore, it is respectfully believed that Claims 23, 25-31, 35, 37-39, 41-44 and 52-59 overcome the rejection under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement.

Rejection under 35 U.S.C. § 112, First Paragraph – Enablement:

Claims 23, 25-31, 35, 37-39, 41-44 and 52-59 were rejected under 35 U.S.C. §112, first paragraph for failing to comply with the enablement requirement. As stated previously, Applicant has attached the Declarations under 37 C.F.R. §1.132 of Mark Yoder (see Appendix 1) and Michael Phillips (see Appendix 2), who are two renown experts in the field of electronic speech recognition. Both experts agree that an "adaptive speaker identity verification system" is a commercially available device and that anyone skilled in the art of deploying an "adaptive speaker identity verification system" would clearly understand this standard industry terminology and would not have to have any additional details regarding the computing platform

such as the processors, memory, and machine-readable media. Both experts further state that: "the Invention disclosed in U.S. Patent Application No. 09/886,824 could be readily made by such a person skilled in the art using a common adaptive speaker identity verification system; **it is a relatively simple and straightforward process that does not require any undue experimentation."** (emphasis added).

The Manual for Patent Examining Procedure ("M.P.E.P.") §2164.01 recites that "[a]ny analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention." The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 US.P.Q.2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 (Fed. Cir. 1988). See also *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988). Moreover, "[a]ny part of the specification can support an enabling disclosure, even a background section that discusses, or even disparages, the subject matter disclosed therein." *Callicrate v. Wadsworth Mfg., Inc.*, 427 F.3d 1361, 77 U.S.P.Q.2d 1041 (Fed. Cir.

2005) (discussion of problems with a prior art feature does not mean that one of ordinary skill in the art would not know how to make and use this feature). Therefore, with both Mark Yoder and Michael Phillips, in their sworn Declarations, clearly indicating that this commercially available device could be easily adapted to use the Applicant's claimed Invention without any undue experimentation, there is strong evidence that Applicant's Invention, as claimed, is fully and completely enabled by a reading of the Applicant's patent application. Moreover, even complex experimentation, **which this is not**, would not lack enablement as long as it is not undue experimentation. *In re Certain Limited-Charge Cell Culture Microcarriers*, 221 U.S.P.Q. 1165, 1174 (International Trade Commission 1983), aff'd. sub nom.; *Massachusetts Institute of Technology v. A.B. Fortia*, 774 F.2d 1104, 227 U.S.P.Q. 428 (Fed. Cir. 1985). In this situation, due to the fact that this adaptive speaker identity verification system is a commercially available item, it is believed that the nature of the invention and nature of the invention under *In re Wands*, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed. Cir. 1988) would clearly preclude of finding of lack of enablement since the methodology could easily be implemented on this standard commercial device under the reading of U.S. Patent Application No. 09/886,824 based on the sworn testimony of Mark Yoder and Michael Phillips. If a statement of utility in the specification contains within it a connotation of how to use, and/or the art recognizes that standard modes of administration are known and contemplated, 35 U.S.C. 112 is satisfied. *In re Johnson*, 282 F.2d 370, 373, 127 U.S.P.Q. 216, 219 (C.C.P.A. 1960); *In re Hitchings*, 342 F.2d 80, 87, 144 U.S.P.Q. 637, 643 (C.C.P.A. 1965).

Therefore, it is respectfully believed that Claims 23, 25-31, 35, 37-39, 41-44 and 52-59 overcome the rejection under 35 U.S.C. § 112, first paragraph for failing to comply with the enablement requirement.

Rejection under 35 U.S.C. § 101:

Claims 23, 25-31, 35, 37-39, 41-44 and 52-59 were rejected under 35 U.S.C. §101 for failing to provide patentable utility. As previously stated, Applicant has attached the Declarations under 37 C.F.R. §1.132 of Mark Yoder (see Appendix 1) and Michael Phillips (see Appendix 2), who are two renown experts in the field of electronic speech recognition. Both individuals clearly indicate that the term "adaptive speech recognition system" is well known in the art for a specific type of commercially available machine that digitizes an analog voice signal and analyzes the digital voice signal using a processor to recognize the identity of the speaker. Moreover, it is respectfully believed that the term "adaptive" clearly indicates the presence of a machine and precludes this function being performed by a human being.

The test set forth by the Federal Circuit under *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) is a two-prong "machine-or-transformation" test for determining whether an invention qualifies as patent-eligible subject matter. To summarize, in *Bilski*, the court announced that a "process" claim recites patent-eligible subject matter if "(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing." *Bilski*, 545 F.3d at 954. In this case, an "adaptive speech recognition system" is a commercially available machine that digitizes an analog voice signal and analyzes the digital voice signal using a processor to

recognize the identity of the speaker. It is respectfully believed to be undeniable that the Applicant's Invention, as claimed, is a machine. Since there is the electronic feature of digitizing analog voice signals, this machine is much more than a processor. So even using the standards set forth by the United States Patent and Trademark Office's Board of Patent Appeals and Interferences ("BPAI"), which has not been adopted by the Federal Circuit, this machine claimed by the Applicant is much more sophisticated and cannot be construed as just a "general purpose processor." See *Ex parte Langemyr*, No. 2008-1495 (B.P.A.I. 2008).

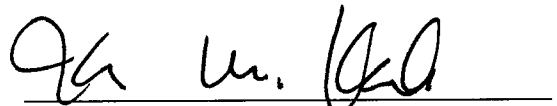
It is respectfully believed that adaptive speech recognition using a commercially available machine that digitizes an analog voice signal and analyzes the digital voice signal using a processor provides a clearly patentable item, i.e., a machine, with a very specific and substantial utility of eliminating fraud, i.e., speaker identity verification. A "specific utility" is specific to the subject matter claimed and can "provide a well-defined and particular benefit to the public." *In re Fisher*, 421 F.3d 1365, 1371, 76 U.S.P.Q.2d 1225, 1230 (Fed. Cir. 2005). It is respectfully believed this fully comports with the "Examination Guidelines for the Utility Requirement" listed in §2107 of the Manual of Patent Examining Procedure (M.P.E.P.).

Therefore, it is respectfully believed that Claims 23, 25-31, 35, 37-39, 41-44 and 52-59 overcome the rejection under 35 U.S.C. § 101 for failing to provide patentable utility.

CONCLUSION

Therefore, it is now believed that all of the pending Claims, i.e., Claims 23, 25-31, 35, 37-39, 41-44 and 52-59, in the present application are in condition for allowance. Favorable action and allowance of the Claims is therefore respectfully requested. If any issue regarding allowability of any of the pending Claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's Amendment, or if the Examiner should have any questions regarding the present Amendment, it is respectfully requested that the Examiner please telephone the Applicant's undersigned attorney in this regard.

Respectfully submitted,

By: 

Kevin M. Kercher, Reg. No. 33,408
Thompson Coburn LLP
One US Bank Plaza
St. Louis, MO 63101-1693
(314) 552-6345
(314) 552-7345 (fax)
Attorney for Applicant
Dated: July 14, 2009